

REMARKS

Applicant has reviewed the comments and rejections set forth by the Examiner in the Office Action dated April 29, 2005 and respectfully respond with the amendments above and the following remarks. Claims 1-7, 9-15 and 17-23 are pending in the present case. Claims 1-7, 9-15 and 17-23 are rejected. Claims 1-7, 9 and 17 are amended herein. Applicant respectfully requests reconsideration in view of the above amendments and the arguments set forth below.

35 U.S.C. §101

In the previous Office Action received for the present application, specifically the Office Action mailed on April 29, 2005, Claims 1-8 were rejected under 35 U.S.C. § 101 as the Examiner asserts that the claimed invention was directed to non-statutory subject matter. Applicants amended Claims 1-7, adding the limitation "computer implemented" to overcome the rejection under 35 U.S.C. § 101 in the Response mailed on July 29, 2005. Claim 8 was cancelled without prejudice.

In the previous rejections under 35 U.S.C. § 101, the Examiner asserted that the rejected claims fail to satisfy a test of whether an invention is within the "technological arts." In particular, the Examiner asserted that by failing a separate test as to whether the invention is within the "technological arts," the

invention as claimed in Claims 1-8 was not directed towards statutory subject matter.

Applicants respectfully submit that the test for patentable subject matter under 35 U.S.C. § 101 does not include a separate “technological arts” test (*ex parte Lundgren*, Board of Patent Appeals and Interferences, Appeal No. 2003-2088, 9/28/05). The court in *ex parte Lundgren* held that “[w]e do not view the court’s statement in Musgrave in regard to the technological arts to have created a separate “technological arts” test in determining whether a process is statutory subject matter” (Id., emphasis in original). In particular, the court held “that there is currently no judicially recognized separate “technological arts” test to determine patent eligible subject matter under § 101” (Id., emphasis added). The court also declined to create such a test (Id.).

Applicants respectfully submit that the recent BPAI decision of *ex parte Lundgren* clearly indicates that there is no test to determine whether the invention is within the “technological art” in order to be eligible for a patent. Applicants have amended Claims 1-7 herein, removing the previous amendments made for the purpose of overcoming the previous rejections under 35 U.S.C. § 101. Accordingly, Applicants respectfully submit that Claims 1-7 are directed toward patentable subject matter, and are not subject to a rejection under 35 U.S.C. § 101.

35 U.S.C. §103(a)

Claims 1-7, 9-15 and 17-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent 6,021,398 by Ausubel, hereinafter referred to as the “Ausubel” reference, in view of United States Patent 6,415,270 by Rackson et al., hereinafter referred to as the “Rackson” reference, further in view of United States Patent 6,131,087 by Luke et al., hereinafter referred to as the “Luke” reference. Applicants have reviewed the cited references and respectfully submit that the present invention as recited in Claims 1-7, 9-15 and 17-23 is patentable over Ausubel in view of Rackson, further in view of Luke.

Applicant respectfully directs the Examiner to independent Claim 1 that recites that an embodiment of the present invention is directed to (emphasis added):

A method for determining a preference policy for a market, said method comprising:
selecting characteristics of said market, wherein said market comprises an auction market;
selecting a relevant bidding model;
estimating a structure of said market;
predicting a bidding behavior;
predicting a first outcome of said market; and
evaluating said first outcome of said market, wherein said evaluating comprises:
selecting a best preference policy from a plurality of candidate preference policies for treating different groups of bidders differently, wherein said best preference policy comprises the candidate preference policy within a plurality having the highest ranking; and
outputting said best preference policy.

Independent Claims 9 and 17 include similar limitations. Claims 2-7 that depend from independent Claim 1, Claims 10-15 that depend from independent Claim 9, and Claims 18-23 that depend from independent Claim 17, provide further recitations of the features of the present invention.

Applicants respectfully assert that Ausubel does not teach, describe or suggest “selecting a best preference policy from a plurality of candidate preference policies for treating different groups of bidders differently, wherein said best preference policy comprises the candidate preference policy within a plurality having the highest ranking” as claimed. Applicants respectfully direct Examiner to Examiner’s comments supporting the rejection of 1-7, 9-15 and 17-23, where Examiner states the “Ausubel does not explicitly disclose ... [s]electing a best preference policy from a plurality of candidate preference policies, wherein said best preference policy comprises the candidate preference policy within a plurality having the highest ranking” (see Detailed Action, paragraph spanning bottom of page 2 and top of page 3).

Moreover, the combination of Ausubel in view of Rackson fails to teach or suggest this claim limitation because Rackson does not overcome the shortcomings of Ausubel. Applicants understand Rackson to teach an Internet based auction system where users specify parameters of an item for sale and bidders submit bids for the items. Applicants respectfully assert that Rackson

does not teach, describe or suggest “selecting a best preference policy from a plurality of candidate preference policies for treating different groups of bidders differently, wherein said best preference policy comprises the candidate preference policy within a plurality having the highest ranking” as claimed. In particular, Applicants respectfully submit that Rackson is silent as to a preference policy as claimed.

Furthermore, the combination of Ausubel in view of Rackson, further in view of Luke fails to teach or suggest this claim limitation because Luke does not overcome the shortcomings of Ausubel in view of Rackson. Applicants understand Luke to teach a method for market participants for automatically identifying and matching offer data with solicitation data. In particular, the market participants submit an offer including a preferred point for each dimension of the offer. The preferred points of the offers are compared to the preferred points of the solicitation data (Abstract).

Applicants understand that the preferred points for each offer are user submitted, and that the preferred points are used for differentiating among offers. In particular, Applicants respectfully assert that the preferred points are used for matching offers, and thus treat each offer individually. Therefore, Luke teaches that each market participant is treated individually. Specifically, Luke does not teach, describe or suggest “selecting a best preference policy from a plurality of candidate preference policies for treating different groups of bidders differently,

wherein said best preference policy comprises the candidate preference policy within a plurality having the highest ranking,” as claimed (emphasis added). In contrast, Luke is silent as to the grouping of market participants.

Applicants respectfully assert that nowhere does the combination of Ausubel in view of Rackson, further in view of Luke teach, disclose or suggest “selecting a best preference policy from a plurality of candidate preference policies for treating different groups of bidders differently, wherein said best preference policy comprises the candidate preference policy within a plurality having the highest ranking,” as recited in independent Claims 1, 9 and 17, that these claims overcome the rejection under 35 U.S.C. § 103(a), and are thus in condition for allowance (emphasis added). Applicants respectfully submit the combination of Ausubel in view of Rackson, further in view of Luke also does not teach or suggest the additional claimed features of the embodiment of the present invention as recited in Claims 2-7 that depend from independent Claim 1, Claims 10-15 that depend from independent Claim 9, and Claims 18-23 that depend from independent Claim 17. Therefore, Applicants respectfully submit that Claim 2-7, 10-15 and 18-23 overcome the rejection under 35 U.S.C. § 103(a), and that these claims are thus in a condition for allowance as being dependent on allowable base claims.

CONCLUSION


In light of the above remarks, Applicants respectfully request reconsideration of the rejected claims. Based on the arguments presented above, Applicants respectfully assert that Claims 1-7, 9-15 and 17-23 overcome the rejections of record and, therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

WAGNER, MURABITO & HAO, LLP

Dated: 2/3, 2006



John P. Wagner
Reg. No. 35,398

WAGNER, MURABITO & HAO, LLP
Two North Market Street, Third Floor
San Jose, CA 95113
Tel.: (408) 938-9060
Fax: (408) 938-9069

U.S. Serial No.: 09/902,880
10014418-1

Examiner: Dass, Harish T.
Art Unit: 3628